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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/722,590  | 11/25/2003  | Stephen Russak       | 00467/100M163-US1      | 5682             |
| 7278  | 7590        | 07/08/2005           |                        | EXAMINER         |
| DARBY & DARBY P.C.<br>P. O. BOX 5257<br>NEW YORK, NY 10150-5257 |             |                      | VERBITSKY, GAIL KAPLAN |                  |
|   |             |                      | ART UNIT               | PAPER NUMBER     |
|   |             |                      | 2859                   |                  |

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 10/722,590             | RUSSAK ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gail Verbitsky         | 2859                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 20 April 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-12 and 14-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-12 and 14-22 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date . . .  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Claim Objections*

1. Claims 1 and 8 are finally objected to because of the following informalities:

Claim 1: perhaps applicant should replace "calibrates" with -- wherein, the actuation switch activates calibration of—, in order to clearly describe the invention.

Claim 8: Perhaps applicant should insert –one of—after "from" in line 2, in order to properly describe the invention.

Claim 21: "the first member" lacks antecedent basis. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12, 14-16 and 22 are finally rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it is not clear how the "actuation switch" is structurally related to other elements of claim 1. Perhaps applicant should cancel claim 12 and add the limitations of claim 12 in claim 1, in order to properly describe the invention. Also, see claim objection to claim 1 in paragraph 1 of the present Office action.

Claims 2-12, 14-16 and 22 are rejected by virtue of their dependency on claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP61270631A [hereinafter JP] in view of Yerlikaya et al. (U.S. 20030002562, effective filing date 08/28/2001) [hereinafter Yerlikaya].

For claims 17, 20: JP discloses in Figs. 1a-c and 3 a clinical thermometer comprising a second member (disk-shaped) attached to a proximal end of a first member (an elongated arcuately shaped temperature probe), the second member has a proximal and a distal end. The first member has lower portion A and an upper portion B having a perimeter and an edge C along the perimeter; the temperature sensor is located at the edge C.

For claim 19: as shown in Fig. 1a, the second member is cylindrically shaped and disposed at the proximal end of the first member (probe).

For claim 18: the probe has a proximal end D and a distal end E.

For claim 21: JP discloses in Figs. 1a-c and 3 a (one piece) clinical thermometer comprising a single disk-shaped member having a circumferential edge and upper and lower portions, the member comprising a temperature display, an actuation switch and a (at least one) temperature sensor/ probe positioned at the

circumferential edge and connected to a circuitry inside the member. The temperature sensor/ probe is arcuate-shape. The temperature sensor is a part (attachment to) of the single disk-shaped member and adapted to take temperature measurements. The temperature sensor/ probe has a shaped distal end (first member) E; the distal end is shaped to be disposed in the patients' cavity.

As shown in Figs. 1a-c and 3, the temperature sensor/ probe is positioned at a point on the circumferential edge of the single disk-shaped member. Since the member is of a circumferential shape, it is inherent, that, during the manufacturing process, the operator can select any point on the circumferential edge and thus, to position the temperature sensor/ probe at any desired position along the edge. (The numerals A-F have been added by the Examiner, see attachment # 3 to the previous Office action).

With respect to the preamble of claims 17 and 21: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

JP is silent if the first member is adapted to take an axillary temperature.

Yerlikaya discloses a clinical thermometer having a fist member (probe distal end) shaped for use for both, oral and axillary temperature taking.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the device disclosed by JP, so as to use it for both, oral and axillary temperature taking, as taught by Yerlikaya, depending on the patient's preference, condition and age.

***Allowable Subject Matter***

6. Claims 1-12, 14-16, 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2859

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

**Shiokawa (U.S. 5178468) discloses in Figs. 15-16 a device in the field of applicant's endeavor comprising a first member 1 adapted to measure an oral and an axillary temperature of a patient.**

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

*Gail Verbitsky*

*Primary Patent Examiner, TC 2800*



June 30, 2005